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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,603	04/06/2000	NICOLA JOHN POLICICCHIO	6873	1426

7590

03/31/2003

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EXAMINER

PRETKA, V WALTER

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 03/31/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/509,603

Applicant(s)

POLICICCHIO ET AL.

Examiner

Walter Pretka

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1746

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-37 and 39-51 is/are pending in the application.
- 4a) Of the above claim(s) 11-30 and 32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 and 45-47 is/are allowed.
- 6) ☒ Claim(s) 31, 33-36, 39-44, & 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112—Withdrawn

1. Applicant's amendments/clarifications have overcome the previously pending 35 USC §112 rejections.

OBVIOUSNESS DOUBLE PATENTING

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 31 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 14 respectively of United States Patent No. 6,380,151 to Masters et al. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because, with respect to claim 31, the limitations of claim 13 of the Masters patent is of a slightly different scope but discloses each and every limitation of claim 33. The term "superabsorbent" is used in lieu of 15 g/g.

3. As to claim 33, claim 14 of the Masters patent is of slightly different scope but discloses each and every limitation of claim 33. The term "super-absorbent" is used in lieu of 15 g/g.

Response to Arguments

4. Applicant's arguments have been carefully considered and are persuasive in distinguishing claims 37, 49 and 51. Applicant's arguments are not persuasive with respect to 31-36, 39-48, and 50.

5. Applicant's credibly stated that they have discovered a problem, and a solution to the problem, and made reference to MPEP 2141.02. The Examiner is familiar//the MPEP. Applicant should note that the motivation for making the instant combination can be, and in fact may preferably be, different from Applicant's motivation. If the motivation existed before the invention, as it must, then the finding of the requisite motivation is proper. In the present case the composition is disclosed in '323. This Examiner does not suggest that the Applicant does not have a patentable invention; rather the invention is simply claimed in a manner that does not avoid the prior art of record.

6. The argument drawn to the disclosure of the amount of surface-active agents has been carefully considered. Inherently emulsifiers include surfactants. Surfactants are surface-active agents, and the emulsifier of the '323 patent is disclosed to be present in the amount disclosed. As such the amendment changing "0.5%" to --0.4%-- will not distinguish the instant invention

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over the '323 reference. Not to suggest that the change, absent a showing of some criticality, would be sufficient to differentiate the claims.

7. The argument that the aggregated references do not disclose a volatile organic compound is noted. Applicant points to claims 37 and 48-51 as claims including this limitation. Claim 37 does disclose an organic compound (and "volatile" will be construed relative to the vapor pressure of the compound.). Despite careful inspection of the indicated claims, several of the indicated claims fail to support the "organic" limitation; this may have been inadvertently omitted. Specifically, claims 48 and 50 do not disclose an organic compound.

8. Page 1, column 2, line 82, of '323 discloses sodium xylene sulphonate and lower aliphatic alcohols. Page 2, column 1, line 30 discloses "sodium xylene sulphonate".

9. Applicant argues that the '110 reference adds nothing because it uses conventional sponge and not a superabsorbent material. Many sponges are fully capable of absorbing about 15g/g. PVA sponges for example.

10. Applicant's arguments with respect to the discovery of "problem discovered herein", is not contested at this time. However the motivation relied on is not the same as that put forth by Applicants.

Claim Rejections - 35 USC § 103—Maintained

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 31, 33-36 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK patent 1,357,323 and United States Patent No. 5,522,110 for the reasons set forth in paper 10 dated 9/18/02.

3. New claims 48 and 50 are rejected for the reason set forth in paper 10 in light of the disclosure of '323 at page 1, column 2, line 82, of '323 disclosing sodium xylene sulphonate and lower aliphatic alcohols. Page 2, column 1, line 30 discloses "sodium xylene sulphonate". The motivation for making the instant combination is the same as set forth in paper 10.

Allowable Subject Matter

4. Claim 37, 45-47 would be allowable if the claims were rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

5. The following is a statement of reasons for the indication of allowable subject matter: Applicant's amendments adding 2-amino-2-methylpropanol, are considered to distinguish the instant claims from the prior art of record. Obviously the determination of patentability hinges on many factors including Applicant's arguments, which are of record, and the other elements that are present in the claims.

Conclusion

6. Claims 49 and 51 would be allowable if the obviousness double patenting rejection is overcome and if the claims are rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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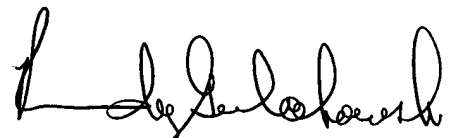
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter Pretka whose telephone number is (703) 305 5103. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (703) 308 4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9310 for regular communications and (703) 873 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 5103.

Walter Pretka
Examiner
Art Unit 1746

WP
March 24, 2003

A handwritten signature in black ink, appearing to read 'Randy Gulakowski', with a stylized, cursive script.

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700